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August 21, 2007
Date of Signature

PATENT
Case No. AUS920010138US1
(9000/25)

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

RICHARD D. HOFFMAN, ET AL.

Serial No.: 09/843,068

Filed: APRIL 26, 2001

Title: METADATA GRAPHICAL
USER INTERFACE

Examiner: CAMPBELL, J. D.

Group Art Unit: 2178

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is Appellants' Reply Brief.

The Examiner continues to erroneously reject these claims. Two issues are before the Board – the erroneous §112 rejections as outlined in Appellants’ Second Appeal Brief, and certain §103 rejections. The Examiner fails to offer any new evidence in support of his §112 rejections, and as previously argued those rejections must fall. However, Appellants note that during the latency of this appeal, the Supreme Court decided *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007), and this reply brief will primarily focus on why *KSR* compels a finding of nonobviousness of these claims. See also, *Ex Parte Catan*, Appeal 2007-0820.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” Furthermore,

to facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Were the combination of Egilsson and Chester as ‘obvious’ as suggested by the Examiner those of skill in the art would have surely made the combination prior to the Appellants. This is especially true in a field as subject to rapid advancement and rapid innovation as the field of graphical user interfaces. As noted by the BPAI in *Ex Parte Catan*:

The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986). In determining this skill level, the court may consider various factors including “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Id.* (cited in *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995)). In a given case, every factor may not be present, and one or more factors may predominate. *Id.* at 962-63, 1 USPQ2d at 1201.

In particular, the Egilsson reference was filed almost *five years* prior to this matter, and Chester published four years prior to this matter. In a field as rapidly advancing as GUI, a time gap of four or five years *all but precludes* a finding of obviousness, since the combination would have been known given the rapidity of innovation, the sophistication of this technology and the exceptionally high educational level of active workers in the field. Thus, the Examiner’s *ad hoc* combination herein is not simply a matter of substituting one element for another element, but instead is an example of impermissible hindsight. The Examiner has ignored the mandatory *Graham* factors, and ignored the need to consider the person of ordinary skill in the art.

In addition, without identifying the skill level of one of ordinary skill in the art, the Examiner cannot support an allegation of obviousness with a naked assertion that such knowledge would be within that person. Indeed, there must be a finding “as to the specific understanding or principle within the knowledge of the skilled artisan.” *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), MPEP §2143.01 (even for “technologically simple concepts” there must be a finding). The Examiner must ascertain what would have been obvious to one of ordinary skill in the art, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses within the art. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693 (Fed Cir. 1983), MPEP §2141.03. The failure to identify the level of skill possessed by one of ordinary skill in the art means that this rejection cannot stand.

Instead of providing an appropriate analysis under Graham, the Examiner simply alleges that the combination “would have allowed easy import and export of files in a standard format”. However, the Examiner cannot conclusively assert that use of the Chester “conversion of spreadsheet files into CSV files” would assist in the creation of an “application building and managing environment in which users of computer systems, including ones with minimal programming knowledge, create and share powerful software applications, as Egilsson teaches is desirable. See, Egilsson, col. 1, lines 12-16. This is particularly true in light of the fact that Egilsson does not denounce its graphical environment for managing and developing applications as anything less than an ideal solution to the problems, and in light of the fact that Chester does not pronounce its “conversion of spreadsheet files into CSV files” as the ultimate method of displaying metadata.

Here, the Examiner has apparently simply added the proverbial 1+1 to allege obviousness, but this is antithetical to the mandates of the law. Obviousness requires more than a simple addition, and requires that there be motivation to combine the references in the fashion that the Examiner *ex post facto* suggests.

The Examiner's allegation (p. 9 of the August 9, 2006 action) that Egilsson teaches the use of spreadsheets is not relevant, even if true. Egilsson does not teach that it would be desirable to provide a method of importing/exporting data in CSV without user interaction – at most, Egilsson teaches that a spreadsheet user to create general software without abandoning spreadsheet methodology. The Examiner errs in failing to consider the chasm between using a spreadsheet to create general software and importing data in CSV without user interaction. Egilsson does not make any teachings that would direct those of skill in the art to seek out the teachings of Chester in order to assist in the creation of general software using a spreadsheet, and Egilsson does not make any teachings that would suggest the desirability of the claimed invention.

Therefore, the Examiner cannot support this §103(a) rejection over Egilsson in view of Chester, and Appellants request withdrawal of all rejections.

CONCLUSION

The Appellants respectfully submit that claims 1-18 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **August 21, 2007**

Respectfully submitted,
RICHARD D. HOFFMAN, *et al.*

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